

REMARKS

Summary of the Amendment

Upon entry of the above amendment, claims 4, 5 and 26-36 will have been canceled, claim 1 will have been amended, and claims 37-40 will have been added. Accordingly, claims 1-3, 6-25, 37-40 will be pending with claims 1, 37 and 39 being in independent form.

Summary of the Official Action

In the instant Office Action, the Examiner reiterated the previous restriction requirement, made the restriction requirement final, and withdrew claims 26-36 from examination. Finally, the Examiner rejected claims 1-25 over the art of record. By the present amendment and remarks, Applicant submits that the rejections have been overcome, and respectfully requests reconsideration of the outstanding Office Action and allowance of the present application.

Traversal of Rejection Under 35 U.S.C. § 102

Applicant traverses the rejection of claims 1-4, 6, 9, 10, 14-17 and 21-24 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 3,062,588 to MOLINS et al.

The Examiner asserted that this document discloses all the features recited in these claims including the recited detection device which controls rotation of the drum. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what this document disclose, Applicant submits that MOLINS fails to disclose, or even suggest: inter alia, a detection device that controls a rotation of the drum and detects the filter elements and a mechanism that feeds the filter elements in a lengthwise axial manner to the drum, wherein the filter elements are fed to the filter element magazine in a crosswise axial manner, as recited in amended independent claim 1.

Applicant acknowledges that Fig. 2 of MOLINS shows a device which feeds filter elements from a drum 14 to a stub assembler 10 using a guide means 16. Nor does Applicant dispute that col. 5, lines 10-22 and 48-59 of MOLINS explains that the filter elements 16 can be detected by a detection means 38-41 and that the detections means 38-41 can control the drum 14. However, it is clear from Fig. 2 that the filter elements 26 are fed radially onto the drum 14 from hopper 12 and that the detection means 38-41 detects the filter elements 26 after they leave the drum 14 and while they are positioned in the guide tube 16. The invention, on the other hand, recites a detection device that controls a rotation of the drum and detects the filter elements in combination with a mechanism that feeds the filter elements in a lengthwise axial manner to the drum.

Furthermore, MOLINS is also silent with regard to the filter elements being fed to the filter element magazine in a crosswise axial manner. Indeed, the Examiner has acknowledged as much on page 4 of the instant Office Action.

Thus, Applicant submits that the above-noted claims are not disclosed, or even suggested, by any proper reading of MOLINS.

Applicant further notes that, for an anticipation rejection under 35 U.S.C. § 102 to be
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proper, each element of the claim in question must be disclosed in a single document, and if the document relied upon does not do so, then the rejection must be withdrawn.

Because the applied document fails to disclose or suggest at least the above-noted features of the instant invention, Applicant submits that any proper reading of this document fails to render unpatentable the combination of features recited in at least independent claim 1.

Moreover, Applicant submits that dependent claims 2-3, 6, 9, 10, 14-17 and 21-24 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper reading of MOLINS discloses or suggests, in combination: that the filter elements comprise filter rods as recited in claim 2; that the filter elements comprise rod-shaped filter elements as recited in claim 3; that the detection device comprises a light barrier as recited in claim 6; that the device further comprises at least one fixed element that conveys the filter elements to the drum as recited in claim 9; that the at least one seat comprises a plurality of seats as recited in claim 10; that the device further comprises a retaining mechanism which traps the filter element after the filter element is moved into the at least one seat as recited in claim 14; that the retaining mechanism is movably mounted as recited in claim 15; that the retaining mechanism can move away from the drum when the drum is rotated as recited in claim 16; that the drum is adapted to rotate before the filter element has reached a final position in the at least one seat as recited in claim 17; a filter element receiver station comprising the device of claim 1 as recited in claim 21; an arrangement for conveying filter elements to a

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filter element magazine, comprising at least one device according to claim 1 and the filter element magazine, wherein the at least one device is arranged outside the filter element magazine as recited in claim 22; that the at least one device comprises a plurality of devices as recited in claim 23; that the plurality of devices comprises three devices as recited in claim 24; that the plurality of devices are arranged one below the other relative to a horizontal axis running through at least one of the plurality of devices as recited in claim 26.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 102(b).

Traversal of Rejections Under 35 U.S.C. § 103(a)

Over Molins with Bostelmann or Hinchcliffe

Applicant respectfully traverses the rejection of claims 5, 7, 8 and 20 under 35 U.S.C. § 103(a) as unpatentable over MOLINS in view of either US Patent No. 5,641,250 to BOSTELMANN et al. or US Patent No. 4,245,934 to HINCHCLIFFE et al.

The Examiner acknowledged that MOLINS lacks, among other things, the recited features of these claims. However, the Examiner asserted that the missing features are nevertheless taught in either BOSTELMANN or HINCHCLIFFE, and that it would have been obvious to modify MOLINS to include the missing features allegedly disclosed in either BOSTELMANN or HINCHCLIFFE. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what each of these documents disclose or suggest, Applicant submits that no proper combination of these documents {P24085.00042773.DOC}

disclose or suggest: inter alia, a detection device that controls a rotation of the drum and detects the filter elements and a mechanism that feeds the filter elements in a lengthwise axial manner to the drum, wherein the filter elements are fed to the filter element magazine in a crosswise axial manner, as recited in amended independent claim 1.

As explained above, while Applicant acknowledges that Fig. 2 of MOLINS shows a device which feeds filter elements from a drum 14 to a stub assembler 10 using a guide means 16 and that col. 5, lines 10-22 and 48-59 of MOLINS explains that the filter elements 16 can be detected by a detection means 38-41, and that the detections means 38-41 can control the drum 14, it is clear from Fig. 2 that the filter elements 26 are fed radially onto the drum 14 from hopper 12 and that the detection means 38-41 detects the filter elements 26 after they leave the drum 14 and while they are positioned in the guide tube 16. In contrast, the invention recites a detection device that controls a rotation of the drum and detects the filter elements in combination with a mechanism that feeds the filter elements in a lengthwise axial manner to the drum. Furthermore, the Examiner has acknowledged on page 4 of the instant Office Action that MOLINS is silent with regard to the filter elements being fed to the filter element magazine in a crosswise axial manner.

BOSTELMANN does not cure the above-noted deficiencies of MOLINS. While Applicant acknowledges that Figs. 2-3 of BOSTELMANN shows a device which feeds rod-shaped articles 3 from a drum 1 using a conveyor 21, it is clear from Figs. 2-3 that the elements 3 are fed radially onto the drum 1 from hopper 16. Furthermore, the Examiner has not explained how BOSTELMANN can be read to disclose or suggest a detection device that controls a rotation of the drum and detects the filter elements in combination
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with a mechanism that feeds the filter elements in a lengthwise axial manner to the drum.

Furthermore, in BOSTELMANN, the filter rods are discharged from a magazine by way of a discharge conveyor drum in a cross axial manner. At a certain point along the path, the filter rods are expelled by pressure out of the receptacles the conveyor drum. By expelling the filter rods in a lengthwise axial manner, the filter rods are conveyed into a tube like conveyor.

HINCHCLIFFE also does not cure the above-noted deficiencies of MOLINS. While Applicant acknowledges that Figs. 1-2 of HINCHCLIFFE shows a device which feeds cigarettes 4 from a drum 60 using a tube 6, it is not apparent how the elements 4 are fed onto the drum 60. Furthermore, the Examiner has not explained how HINCHCLIFFE can be read to disclose or suggest a detection device that controls a rotation of the drum and detects the filter elements in combination with a mechanism that feeds the filter elements in a lengthwise axial manner to the drum.

Furthermore, in HINCHCLIFFE, the rod-like articles are conveyed in a pneumatic carrier tube in a capsule in order to prevent degradation during conveyance.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest the features recited in at least amended independent claim 1. Because no proper modification of MOLINS in view of either BOSTELMANN or HINCHCLIFFE discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper modification of MOLINS with either BOSTELMANN or HINCHCLIFFE can render unpatentable the combination of features recited in at least independent claim 1.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or
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suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claim 1 is not rendered obvious by any reasonable inspection of these disclosures.

Applicant directs the Examiner's attention to the guidelines identified in M.P.E.P section 2141 which state that "[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As this section clearly indicates, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Moreover, it has been legally established that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the

reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references)."

Additionally, it has been held that a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Finally, Applicant submits that dependent claims 7, 8 and 20 are allowable at least for the reason that this claim depends from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper combination of MOLINS and either BOSTELMANN or HINCHCLIFFE discloses or suggests, in combination: that the drum interacts with a mechanical element that causes a crosswise axial insertion of the filter elements into the filter element magazine as recited in claim 7; that the device further comprises a mechanism that causes a crosswise axial insertion of the filter elements into the filter element magazine as recited in claim 8; and that the device further comprises an ejection mechanism adapted to eject defective filter elements as recited in claim 20;

Accordingly, Applicant requests that the Examiner reconsider and withdraw the
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above-noted rejection under 35 U.S.C. § 103(a) and indicate that these claims are allowable over the applied art of record.

Over Molins with Heitmann

Applicant respectfully traverses the rejection of claims 11-13 under 35 U.S.C. § 103(a) as unpatentable over MOLINS in view of either US Patent No. 4,618,293 to HEITMANN.

The Examiner acknowledged that MOLINS lacks, among other things, the recited features of these claims. However, the Examiner asserted that the missing features are nevertheless taught in HEITMANN, and that it would have been obvious to modify MOLINS to include the missing features allegedly disclosed in HEITMANN. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what each of these documents disclose or suggest, Applicant submits that no proper combination of these documents disclose or suggest: inter alia, a detection device that controls a rotation of the drum and detects the filter elements and a mechanism that feeds the filter elements in a lengthwise axial manner to the drum, wherein the filter elements are fed to the filter element magazine in a crosswise axial manner, as recited in amended independent claim 1.

As explained above, while Applicant acknowledges that Fig. 2 of MOLINS shows a device which feeds filter elements from a drum 14 to a stub assembler 10 using a guide means 16 and that col. 5, lines 10-22 and 48-59 of MOLINS explains that the filter elements 16 can be detected by a detection means 38-41, and that the detections means {P24085 00042773.DOC}

38-41 can control the drum 14, it is clear from Fig. 2 that the filter elements 26 are fed radially onto the drum 14 from hopper 12 and that the detection means 38-41 detects the filter elements 26 after they leave the drum 14 and while they are positioned in the guide tube 16. In contrast, the invention recites a detection device that controls a rotation of the drum and detects the filter elements in combination with a mechanism that feeds the filter elements in a lengthwise axial manner to the drum. Furthermore, the Examiner has acknowledged on page 4 of the instant Office Action that MOLINS is silent with regard to the filter elements being fed to the filter element magazine in a crosswise axial manner.

HEITMANN does not cure the above-noted deficiencies of MOLINS. While Applicant acknowledges that the figure of HEITMANN shows a device which feeds rod-shaped articles 4 from station 1/A using conveyor pipes 3, the Examiner has not explained how HEITMANN can be read to disclose or suggest a detection device that controls a rotation of the drum and detects the filter elements in combination with a mechanism that feeds the filter elements in a lengthwise axial manner to the drum.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest the features recited in at least amended independent claim 1. Because no proper modification of MOLINS in view of HEITMANN discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper modification of MOLINS with HEITMANN can render unpatentable the combination of features recited in at least independent claim 1.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the
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Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claim 1 is not rendered obvious by any reasonable inspection of these disclosures.

Additionally, Applicant submits that dependent claims 11-13 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper combination of MOLINS and HEITMANN discloses or suggests, in combination: that the device further comprises a braking element which engages the filter element as recited in claim 11; that the braking element acts to provide braking to the filter element once the filter element is moved into the at least one seat as recited in claim 12; and that the braking element acts to provide braking to the filter element as the filter element is moved into the at least one seat as recited in claim 14.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that these claims are allowable over the applied art of record.

Over Molins '588 with Molins '239

Applicant respectfully traverses the rejection of claims 18 and 19 under 35 U.S.C. § 103(a) as unpatentable over MOLINS '588 in view of US Patent No. 5,365,239 to MOLINS et al.

The Examiner acknowledged that MOLINS '588 lacks, among other things, the
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recited features of these claims. However, the Examiner asserted that the missing features are nevertheless taught in MOLINS '239, and that it would have been obvious to modify MOLINS '588 to include the missing features allegedly disclosed in MOLINS '239. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what each of these documents disclose or suggest, Applicant submits that no proper combination of these documents disclose or suggest: inter alia, a detection device that controls a rotation of the drum and detects the filter elements and a mechanism that feeds the filter elements in a lengthwise axial manner to the drum, wherein the filter elements are fed to the filter element magazine in a crosswise axial manner, as recited in amended independent claim 1.

As explained above, while Applicant acknowledges that Fig. 2 of MOLINS '588 shows a device which feeds filter elements from a drum 14 to a stub assembler 10 using a guide means 16 and that col. 5, lines 10-22 and 48-59 of MOLINS '588 explains that the filter elements 16 can be detected by a detection means 38-41, and that the detections means 38-41 can control the drum 14, it is clear from Fig. 2 that the filter elements 26 are fed radially onto the drum 14 from hopper 12 and that the detection means 38-41 detects the filter elements 26 after they leave the drum 14 and while they are positioned in the guide tube 16. In contrast, the invention recites a detection device that controls a rotation of the drum and detects the filter elements in combination with a mechanism that feeds the filter elements in a lengthwise axial manner to the drum. Furthermore, the Examiner has acknowledged on page 4 of the instant Office Action that MOLINS '588 is silent with regard to the filter elements being fed to the filter element magazine in a crosswise axial manner.
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MOLINS '239 does not cure the above-noted deficiencies of MOLINS '588. While Applicant acknowledges that Figs. 1-4 of MOLINS '239 shows a device which feeds rod-shaped articles S from a hopper 100 to a drum 24 and then from the drum 24 using a conveyor pipe 1, the Examiner has not explained how MOLINS '239 can be read to disclose or suggest a detection device that controls a rotation of the drum and detects the filter elements in combination with a mechanism that feeds the filter elements in a lengthwise axial manner to the drum. Applicant emphasizes that MOLINS '239 merely discloses that the elements S can be fed from the drum 24 to the pipe 24 in an axial direction and does not disclose that the elements are fed in a lengthwise axial manner to the drum.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest the features recited in at least amended independent claim 1. Because no proper modification of MOLINS '588 in view of MOLINS '239 discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper modification of MOLINS '588 in view of MOLINS '239 can render unpatentable the combination of features recited in at least independent claim 1.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claim 1 is not rendered obvious by any reasonable inspection of these disclosures.

Finally, Applicant submits that dependent claims 18 and 19 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper combination of MOLINS '588 in view of MOLINS '239 discloses or suggests, in combination: that the drum includes an element for aligning the filter elements as recited in claim 18; and that the device further comprises a mechanism for aligning the filter elements on the drum as recited in claim 19.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that these claims are allowable over the applied art of record.

Over Molins with Heitmann

Applicant respectfully traverses the rejection of claim 25 under 35 U.S.C. § 103(a) as unpatentable over MOLINS '588 in view of US Patent No. 3,827,757 to HEITMANN et al.

The Examiner acknowledged that MOLINS '588 lacks, among other things, the recited features of this claim. However, the Examiner asserted that the missing features are nevertheless taught in HEITMANN '757, and that it would have been obvious to modify MOLINS '588 to include the missing features allegedly disclosed in HEITMANN '757. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what each of these documents disclose or suggest, Applicant submits that no proper combination of these documents
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disclose or suggest: inter alia, a detection device that controls a rotation of the drum and detects the filter elements and a mechanism that feeds the filter elements in a lengthwise axial manner to the drum, wherein the filter elements are fed to the filter element magazine in a crosswise axial manner, as recited in amended independent claim 1.

As explained above, while Applicant acknowledges that Fig. 2 of MOLINS '588 shows a device which feeds filter elements from a drum 14 to a stub assembler 10 using a guide means 16 and that col. 5, lines 10-22 and 48-59 of MOLINS '588 explains that the filter elements 16 can be detected by a detection means 38-41, and that the detections means 38-41 can control the drum 14, it is clear from Fig. 2 that the filter elements 26 are fed radially onto the drum 14 from hopper 12 and that the detection means 38-41 detects the filter elements 26 after they leave the drum 14 and while they are positioned in the guide tube 16. In contrast, the invention recites a detection device that controls a rotation of the drum and detects the filter elements in combination with a mechanism that feeds the filter elements in a lengthwise axial manner to the drum. Furthermore, the Examiner has acknowledged on page 4 of the instant Office Action that MOLINS '588 is silent with regard to the filter elements being fed to the filter element magazine in a crosswise axial manner.

HEITMANN '757 does not cure the above-noted deficiencies of MOLINS '588. While Applicant acknowledges that Figs. 1-4 of HEITMANN '757 shows a device which feeds rod-shaped articles 3 from a supply 7 to a drum 1 and then from the drum 1 using a conveyor tube 14, the Examiner has not explained how HEITMANN '757 can be read to disclose or suggest a detection device that controls a rotation of the drum and detects the filter elements in combination with a mechanism that feeds the filter elements in a (P24085 00042773.DOC)

lengthwise axial manner to the drum. Applicant emphasizes, in particular, that HEITMANN '757 merely discloses that the elements 3 can be fed from the drum 1 to the pipe 14 in an axial direction and does not disclose that the elements are fed in a lengthwise axial manner to the drum.

Thus, Applicant submits that the above-noted documents fail to disclose or suggest the features recited in at least amended independent claim 1. Because no proper modification of MOLINS '588 in view of HEITMANN '757 discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper modification of MOLINS '588 in view of HEITMANN '757 can render unpatentable the combination of features recited in at least independent claim 1.

Furthermore, Applicant submits that there is no motivation or rationale disclosed or suggested in the art to modify any of the applied documents in the manner asserted by the Examiner. Nor does the Examiner's opinion provide a proper basis for these features or for the motivation to modify these documents, in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claim 1 is not rendered obvious by any reasonable inspection of this disclosure.

Finally, Applicant submits that dependent claim 25 is allowable at least for the reason that this claim depends from an allowable base claim and because this claim recites additional features that further define the present invention. In particular, Applicant submits that no proper combination of MOLINS '588 in view of HEITMANN '757 discloses or suggests, in combination: that the plurality of devices are arranged one below the other

relative to a horizontal axis running through at least one of the plurality of devices as recited in claim 25.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the above-noted rejection under 35 U.S.C. § 103(a) and indicate that these claims are allowable over the applied art of record.

New Claims are also Allowable

Applicant submits that the new claims 37-40 are allowable over the applied art of record. Specifically, 37-40 recite a combination of features which are clearly not disclosed or suggested by the applied art of record. Accordingly, Applicant respectfully requests consideration of these claims and further requests that the above-noted claims be indicated as being allowable.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as recited in each of the pending claims. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no
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estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

The Commissioner is hereby authorized to refund excess payments and charge any additional fee necessary to have this paper entered to Deposit Account No. 19-0089.

Should the Examiner have any further comments or questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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